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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/690,549
Filing Date: October 17, 2000
Appellant(s): RASHKOVSKIY, OLEG B.

Timothy Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/1/2006 appealing from the Office action mailed 10/20/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,446,261	ROSSER	9-2002
6,434,747	KHOO	8-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 47-50 & 55-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosser, (U.S. Pat # 6,664,261).

Considering claim 47, the claimed 'receiver to receive content, an advertisement and update instructions', reads on the operations of the set-top device 44 in Rosser, which receives audio/video, advertisements and insertion information; see Fig. 1; Fig. 2; col. 7, lines 20-58.

'update instructions' are broad enough to read on the LVIS information, such as information attached to a proposed insert, (col. 7, lines 1-19) which are sent from the headend and are used to determine which advertisement(s) will be inserted in the content, using the viewer usage profile data 120, col. 7, lines 45-58. Note, update instructions determine which Ad is shown. Also see Fig. 1 where two different Ads and logos are displayed based on the update instructions.

'a cache, coupled to the receiver, to store the content and the advertisement', is met by the audio and video storage unit 152, which stores audio/video data, including advertisements, col. 5, lines 33-42; col. 7, lines 55-56; col. 11, lines 1-7; col. 11, lines 45-50; col. 13, lines 11-35 & col. 14, lines 44-48.

'a shell, in the receiver, to find a place to insert the advertisement in the cached content before the cached content is to be output for display, such that the receiver receives an update fro the advertisement and automatically replaces the advertisement using the instructions', reads on

the operation in Rosser of inserting different advertisements in different video, based upon the attached category code, compared at least to the viewer usage profile data 120, col. 7, lines 45-58.

Considering claim 48, the claimed 'receiver to receive update with a pointer, such that the receiver uses the pointer to store the update at a location', is inherently included in Rosser, since the LVIS information is specific to a particular program.

Considering claims 49-50, the claimed 'marker', reads on the discussion in Rosser that the insertions are placed at particular points to appear seamless, col. 7, lines 40-45 & col. 14, lines 52-67.

Considering claims 55-56, the advertisement information in Rosser are updated, as periodically as the system downloads new commercial information, see Abstract; col. 4, lines 55-65; col. 7, lines 50-58 & col. 13, lines 12-25, since Rosser teaches that the new advertisements are transmitted and stored on the subscriber terminal.

Considering claim 57, Rosser discloses a set-top device 44.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser, in view of Khoo, (U.S. Pat # 6,434,747).

Considering claims 51-53, the instant claims are directed to storing a list of advertisements, in order to determine whether a particular advertisement has been already stored. However, even though Rosser clearly is enabled to store multiple advertisements, the reference does not explicitly discuss the use of a list. Nevertheless Khoo, which is in the same filed of endeavor, discloses transmitting a list of customized media that is stored on a user terminal, Abstract;; 5, lines 35-50 & col. 8, lines 15-25. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Rosser with the teaching of Khoo providing a list of customized media to a user terminal, at least for the desirable purpose of allowing the user to view the instant items that are stored and make modifications, as taught by Khoo, col. 5, lines 41-52 & col. 11, lines 1-15.

Considering claim 54, the claimed feature of 'uploading the list to a remote server', reads on Khoo, which teaches that when the user modifies the list, that the user personalized data is updated, col. 11, lines 10-15. However, Khoo does specifically state that the updated personalized data is transmitted back to the server. Official Notice is taken that at the time the invention was made, it was well known to store user-personalized data at a server. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Rosser & Khoo with the well known feature of transmitting user-personalized data upstream to be stored at a remote storage unit, at least for the desirable advantage of allowing in the user-personalized data to be more easily shared by a wider variety of vendors.

(10) Response to Argument

Appellant asserts on page 10, that the office action concedes that nothing in Rosser suggests the use of update instructions. Examiner respectfully disagrees; no such concession is made or suggested by the examiner. Examiner points out that the claimed invention recites, "update instructions for said advertisement", whereas appellant arguments on page 10, describe the subject matter as, "update to an advertisement", which may be different from the claim language. For instance, "update to advertisement" would require a change in the advertisement

itself, whereas "update to advertisement", may be a different advertisement or similar to above discussion change to the advertisement itself.

As for "update for advertisement", this reads on the instructions included in the LVIS, such as the warping of the insert and selective use of the occlusion mask reads on update instructions, see col. 7, lines 35-45 & col. 14, lines 52-67, since these items are video processing algorithms that at least change the appearance of the advertisements, which reads on the claimed subject matter.

Furthermore, "update instructions" also reads on the instructions provided in the LVIS that change from one advertisement to another advertisement, such as user enabling key, usage profile keys, and program category code, see col. 7, lines 1-12; col. 7, lines 50-53 & col. 13, lines 25-48. These update instructions in Rosser, replace the default advertisement with an advertisement appropriate for the subscriber's set top box 44.

Appellant argues on page 11, that Rosser does not teach caching both content and advertisement. In the passage, appellant appears to agree that at least advertisements are stored, since appellant points out the portion of Rosser (col. 13, lines 13-20) that discloses alternate video or TV feeds are received and stored in audio & video 152, wherein the alternate video or TV feeds ***are typically*** advertisements, emphasis added. However, examiner points out that by Rosser using the qualifier "typically', clearly means that the alternate video and TV feeds received and stored in audio & video storage 152, is not limited to advertisements. Also, it is

pointed out that the claims do not define the nature of "content", and certainly does not recite that content is video broadcast or video program.

Moreover, it is pointed out that the claim 47 recites, "a cache, coupled to said receiver, to store said content...", which is not a positive recitation that the cache does store the content. In response to appellant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, Rosser clearly teaches that the audio video storage unit 152, (col. 11, lines 1-8) may at least be embodied as RAM memory or a DVD, which are clearly capable of performing the intended use. Furthermore, Rosser discloses that the system may be used a conventional VCR, see col. 5, lines 32-43, thereby storing conventional video programming content.

Moreover, with respect to cached content, examiner contends that such a feature is broad enough to read on any temporary buffering or caching of the video during processing. To that end, it is pointed out that the MPEG 2 standard (Draft International Standard ISO/IEC DIS 13818-2, published 10 May 1994) discloses a frame store memory for buffering during the decompression process, see page 63-64, 73-88 & 103-122. Since, Rosser (col. 7, lines 59-65; col. 10, lines 5-20) discloses the use of MPEG 2 video and decompression thereof, then the reference inherently provides at least a frame store for buffering or caching the frames, which also reads on

the claimed subject matter. Furthermore, in an alternate embodiment, Rosser more explicitly discloses that a delay line 86 is used in the decompression system of Fig. 2, col. 10, lines 5-12.

Regarding the rejection of claim 48, examiner asserted in the Final Office Action that receiving the update with a pointer is inherent in Rosser. Appellant traverses this rejection. Examiner points out that pointer is broad enough to read on the LVIS information attached to the advertisement, which points the particular advertisement to being used by clients with particular profiles.

In the Final Office Action, with respect to claim 54, examiner took Official Notice that at the time the invention was made, it was known in the art to store user-personalized data at a server. Payton, (U.S. Pat # 5,7590,935) is cited as support for this statement. In particular, Payton discloses storing user profiles locally at a set top terminal, or alternatively at a headend, and thus only downloading those recommended items not already stored at the subscriber terminal, see col. 6, lines 1-20 & col. 6, lines 44-60. It would have been obvious for one of ordinary skill in the art at the time the invention made, to modify Rosser with feature of transmitting the user profile information to the server, at least for the desirable advantage of conserving space at he subscriber terminal as taught by Payton, since only those items that are not already stored at the subscriber terminal, are downloaded and stored.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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